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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/959,125	10/28/1997	YOSHIHIKO HIGUCHI	20111-0014	4244

7590 08/12/2005  
WENDEROTH LIND & PONACK, L.L.P.  
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2033 K STREET N.W.  
WASHINGTON, DC 20006

EXAMINER

ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 08/959,125	<b>Applicant(s)</b> HIGUCHI ET AL.	
	<b>Examiner</b> Lyle A. Alexander	<b>Art Unit</b> 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2,3 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3 and 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/9/05</u> . | 6) <input type="checkbox"/> Other: _____  |

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***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-3 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over by EP 0162,303(cited by Applicants on 10/2/98) or the characterization of JP 6-505342 and JP 232855 in NPL document "Dispatch 116024".

EP 162,302 teaches a multilayer analytical element comprising a colorimetric reagent, polymer beads embedded with the claimed light reflective particles and a hydrophilic matrix supporting the reagents and beads. This reference is silent to the claimed single layer construction.

The characterization of JP 6-505342 and JP 232855 in NPL document "Dispatch 116024" teaches a multilayer analytical element comprising a colorimetric reagent, polymer beads embedded with the claimed light reflective particles and a hydrophilic matrix supporting the reagents and beads. This reference is silent to the claimed single layer construction.

It is advantageous to use one piece construction to quicken the manufacturing process and save the cost of the additional layers.

The court decided In re Larson et al. (144 USPQ 347) "... use of one piece construction instead of reference structure is matter of obvious engineering design choice..."

The court decided In re Attwood (117 USPQ 184) that selection of a plurality of individual features incorporated into a unitary structure without materially altering the function of each individual feature and without producing new or unexpected results would have been within the skill of the art.

It would have been within the skill of the art to modify EP 0,162,303, JP 6-505342 or JP 232855 and use one piece construction techniques to gain the above advantages, as a "matter of obvious engineering design choice" and because no unexpected results were achieved.

### ***Response to Arguments***

Applicant's arguments with respect to claims 2-3 and 14-16 have been considered but are moot in view of the new ground(s) of rejection.

Applicants' remarks were convincing with respect to the Obviousness-Type Double Patenting rejections.

Applicants' remarks were convincing with respect to the rejections over "Fukuoka et al.". However, the Office is aware of a related Japanese printed publication "9716720" that presumable contains the same subject matter as the previously cited "Fukuoka et al." documents. This reference has a publication date of 5/9/97. The Office is waiting for a translation of this document. To prevent this document from being applied as prior art in the future, Applicants' should get a certified translation of the

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priority documents so the priority document date is the effective filing date which would precede the "9716720" publication date of 5/9/1997.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lyle A Alexander  
Primary Examiner  
Art Unit 1743

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